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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/161,122	09/25/1998	HONG JIN	7682-45	7220

20583 7590 04/21/2003
PENNIE AND EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 100362711

EXAMINER

LUCAS, ZACHARIAH

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/161,122

Applicant(s)

JIN ET AL.

Examiner

Zachariah Lucas

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1,3-12,14-17 and 19-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18 is/are rejected.
- 7) ☒ Claim(s) 2,13,25 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Status of the Application

1. In this application, claims 1-26 are pending. Claims 2, 13, 18, 25, and 26 are pending and under consideration. Claims 1, 3-12, 14-17, and 19-24 have been withdrawn from consideration as to non-elected inventions.

2. A Final Rejection (the prior action) was mailed in the application on February 6, 2001. The case was abandoned on September 25, 2001, and a petition to revive was granted on May 7, 2002. The current action is in response to a Request for Continued Examination filed September 5, 2002, and a Response filed on January 8, 2003.

3. The Art Unit location of your application, and the examiner to whom the case has been docketed in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Examiner Zachariah Lucas in Art Unit 1648.

Inventorship

4. In view of the papers filed on September 5, 2002, it has been found that this non-provisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37

Art Unit: 1648

CFR 1.48(a). The inventorship of this application has been changed by adding, as inventors, David Kirkwood Clarke, and Peter Palese.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Priority

5. The Applicant's amendment of the application to claim priority to U.S. Provisional Application 60/060,153, filed on September 26, 1997 is noted. As the applicant points out, because this application was filed prior to November 29, 2000, the provisions of 37 CFR § 1.78(a)(3) do not apply. As such, and in view of the submission of the request to correct inventorship as indicated above, the applicant is being accorded priority to the identified provisional application.

6. **(New Objection)** This application filed under former 37 CFR 1.62 lacks the necessary reference to the prior application. A statement reading "This is a (Divisional/Continuation/CIP-choose the appropriate description) of Application No. 08/316,439, filed September 30, 1994 (now U.S. Patent No. 5,840,520)." should be entered following the title of the invention or as the first sentence of the specification.

Drawings

Art Unit: 1648

7. **(Prior Objection-Withdrawn)** The drawings were objected to in the prior action because neither the drawings, nor the Description of the Drawings, provided sequence identification numbers for the sequences disclosed therein. In view of the amendments to the Description of the Drawings made in the response filed September 5, 2002, this objection is withdrawn.

Specification

8. **(Prior Objection-Withdrawn)** The specification was objected to in the prior action because it did not provide sequence identification numbers for the sequences disclosed therein. In view of the amendments to the Description of the Drawings made in the response filed September 5, 2002, this objection is withdrawn.

Claim Objections

9. **(Prior Objection-Withdrawn)** Claims 2, 13, and 18 were objected to because of the following informalities: the full name of the Respiratory Syncytial Virus (RSV) was not provided in the claims upon the first instance of use of the term RSV. In view of the Amendments made in the response filed on September 5, 2002, the objection is withdrawn.

10. **(New Objection)** Claim 2 is objected to because of the following informalities: on line 3 of the claim, it describes "an RSV RNA comprising sequences." The claim should read -- an RSV RNA comprising sequence--. Appropriate correction is required.

Double Patenting

11. **(Prior Rejection- Withdrawn)** Claim 2 was provisionally rejected in the prior action under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of co-pending application 09/368,076. It is noted that claim 15 has been cancelled from the copending application. In view of this, the present obviousness type double patenting rejection is hereby withdrawn.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. **(New Rejection)** Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by the phrase "in which the mRNA coding sequence encodes G and F genes..." This is because polynucleotides encode polypeptides, and not other polynucleotides. It appears that the claim should read on the claimed invention "wherein the mRNA coding sequence encodes G and F proteins..."

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. **(Prior Rejection- Withdrawn)** Claims 2, 13, and 18 were rejected in the prior action under 35 U.S.C. 102(b) as being anticipated by Collins et al., WO 97/12032. The applicant traverses this rejection on the grounds that the application has been amended such that it now claims priority to prior application 08/316,439, which was filed on September 30, 1994. The applicant argues that in view of the amendment, the current application now has priority that predates the cited reference.

16. **(Prior Rejection-Withdrawn)** Claims 2 and 13 were rejected in the prior action under 35 U.S.C. 102(b) as being anticipated by Collins et al., PNAS 92:11563-11567 (1995), hereinafter Collins 1995. The applicant traverses this rejection on the grounds that the application has been amended such that it now claims priority to prior application 08/316,439, which was filed on September 30, 1994. The applicant argues that in view of the amendment, the current application now has priority that predates the cited reference.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. **(Prior Rejection- Withdrawn)** Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins 1995. The applicant traversed this rejection on the same basis as discussed above. As the traversal was found persuasive, the rejection is withdrawn.

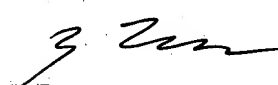
Conclusion

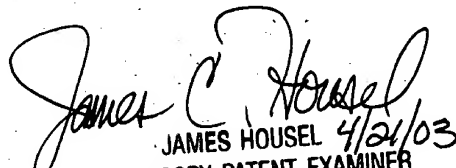
19. The subject matter of claims 2, 13, 25, and 26 appears to be free of the prior art. Claims 13, 25, and 26 are objected to as dependent on a claim that has been objected to.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is 703-308-4240. The examiner can normally be reached on Monday-Friday, 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 703-308-4027. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Z. Lucas
Patent Examiner
April 14, 2003


JAMES HOUSEL 4/21/03
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600